

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed May 23, 2007. Claims 1, 2, 5-7, and 28-32 are currently pending in this Application. No claims have been added, cancelled or amended. The specification has been amended on page 14 to remove an extraneous comment that was not intended to be in the patent application. The removal of this passage on page 14 does not alter the scope of the Claims nor does it constitute new matter. Since the Claims have not been amended, no new search is believed to be necessary. Reconsideration and allowance of the pending claims is respectfully requested in light of the following remarks.

#### ***Claim Rejections – 35 U.S.C. § 102***

In the Office Action, the Examiner rejected Applicants' Claims 1, 2, 28, 29, and 33 under 35 U.S.C. § 102(b) as being anticipated by US Patent Application No. 2002/0059283 to Shapiro et al. ("Shapiro"). The Examiner stated that Shapiro discloses the claimed elements of Applicants' Claims 1, 2, 28, 29, and 33. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Claim 1 of the present application recites in part "wherein the qualifying score is used to determine whether to attempt to sell the product or the service to the potential customer." This element is wholly absent from Shapiro. The Examiner points the Applicant to Figure 7 of Shapiro as teaching "wherein the qualifying score is sued to determine whether to attempt to sell the product or the service to the potential customer." (Office Action dated May 23, 2007, p.3). However, if one reads paragraphs [0074] through [0079] which describe Figure 7 as well as looks at Figures 8a and 8b which relate to Figure 7 and read the corresponding description of Figures 8a and 8b in

paragraphs [0080] through [0081], it is clear that these sections do not teach “wherein the qualifying score is used to determine whether to attempt to sell the product or the service to the potential customer.” Rather these sections of Shapiro teach methods to identify what types of marketing techniques should be aimed at a customer or potential customer as well as the timing of those marketing techniques.

Paragraph [0010] of Shapiro summarizes the advantages of the teachings found within Shapiro and the problems solved. It states in part that “[i]t can be describable for numerical values to be assigned to customer feedback using entirely customizable criteria and numerical thresholds. Different feedback with customers can then automatically result in entirely different follow-up activities, with different customers being treated differently.” Reading Shapiro as a whole, it is clear that it is directed toward determining the scheduling and type of marketing activities to be addressed to a particular customer or potential customer in a customizable format such that different customers are treated differently and in a manner that may result in the most sales. Conspicuously lacking from Shapiro is any teaching or even suggestion of eliminating a potential customer from marketing and sales activity. Shapiro implies that less promising customers who are interested in a less costly item or whose buying timetable is not immediate may have different marketing methods and timing of marketing activities utilized on them than would be utilized on more promising potential customers whose item of interest is costlier or whose time frame for purchase is sooner, but it does not teach or imply a method of eliminating a potential customer from marketing activities.

Thus, it is abundantly clear that Shapiro does not teach every element of Claim 1 identically as presented in Claim 1. Therefore, Claim 1 is not anticipated by Shapiro. Claims 28 and 33 recite similar limitations as Claim 1. Thus, the remarks provided in support of patentability for Claim 1 apply equally to Claims 28 and 33. Therefore, Claims 28 and 33 are not anticipated by Shapiro. Claim 2 depends from Claim 1 and Claim 29 depends from Claim 28 and thus each contains all of the limitations of its respective base claim as well as additional limitations. Therefore, Claims 2 and 29 are also not anticipated by Shapiro.

Therefore, the rejection of Claims 1, 2, 28, 29, and 33 has been overcome. Favorable reconsideration and allowance of these claims is respectfully requested.

***Claim Rejections – 35 U.S.C. § 103***

In the Office Action, the Examiner rejected Applicants' Claims 5-7, 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Shapiro in view of official notice. This rejection is respectfully traversed.

Claims 5-7 and 30-32 depend from Claims 1 or 28 respectively. As shown above, Claims 1 and 28 are not anticipated by Shapiro and are therefore allowable. Since dependent claims include all of the limitations of their base claim as well as additional limitations, if the base claim is allowable, the dependent claim that depends from it is also allowable. Therefore, Claims 5-7 and 30-32 are not rendered obvious by Shapiro in view of the Examiner's official notice.

Therefore, the rejection of Claims 5-7 and 30-32 has been overcome. . Favorable reconsideration and allowance of these claims is respectfully requested.

However, although this is sufficient to overcome the Examiner's rejection, the Applicant also will address the Examiner's official notice. In the Office Action dated May 23, 2007 on page 5, the Examiner states:

Shapiro teaches analyzing feedback from weighted question, but does not specifically mention the specific calculation for determining scoring as is reflected in claims 5-7, 30-32. The examiner takes official notice that the features in the instant claims for determining a score from weighted data were old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shapiro the weighting and calculating features as are found in the instant claims, because these calculation were well known statistical standards that are used to increase the reliability or normalize data, thus producing more accurate results in the prediction.

However, the Examiner does not define what the relevant art is or what the level of skill of the person of ordinary skill in the art would be at the time of the invention nor is a citation provided for what the level of skill of the hypothetical person of ordinary skill in the art would be. In *In re Pardo*, the Federal Circuit held that "the skill of a person of ordinary skill in [the relevant art] ... is not a proper subject for judicial notice today, no matter how simple a claimed invention may seem in hindsight." *In re Pardo*, 684 F.2d 912, 214 USPQ 673 (C.C.P.A. 1982).

The court further stated that

this court will always construe [the rule permitting judicial notice] narrowly and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference

work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.

*Id.* (quoting *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (C.C.P.A. 1970)) (citations omitted) (alterations in original).

Thus, without an identification of the relevant art and since it is not a proper subject of judicial or examiner official notice, the Applicant is left in the position of being unable to present a complete rebuttal to the Examiner's official notice since it is not clear what the Examiner is considering the relevant art. It is the Applicant's belief that the person of ordinary skill in the art is one with a background in marketing and some computer software experience. Those skilled in marketing are not generally known for their mathematical and statistical skills, but rather for their perception of human desires and motivations so as to most effectively market a product to someone. Furthermore, the nature of these problems indicate that the first and principal requirement of the person of ordinary skill in the art is marketing rather than computer software as it is the familiarity with the problems associated with marketing that are the impulse for the development of marketing software. Additionally, many software programmer's are self taught or have learned their skills through various community college courses and the nature of computer programming is such that many software codes may be written by non-experts in the field who may not have the same mathematical and statistical background as the experts. Thus, the Applicant believes that the person of ordinary skill in the art at the time of the invention would not be familiar with a variety of statistical methods for improving their product.

Additionally, it is not generally proper for the Examiner to take official notice of facts without documentary evidence in support of the assertion. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). In certain older cases, official notice has been taken of a fact that is asserted to be "common knowledge" without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as

when other references of record supported the noticed fact, or where there was nothing of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (accepting the examiner's assertion that the use of "a control is standard procedure throughout the entire field of bacteriology" because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting the examiner's finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement). If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

In the present case, the Examiner has made only a cursory attempt at providing sound reasoning for the official notice taking and has provided no documentary evidence to back up the statement. Furthermore, since the Examiner has based the 103 rejection on personal knowledge, the decision is thus based on facts that are not easily combatable or contestable by the Applicant. Therefore, if the Examiner wishes to maintain the rejection based on official notice, the Applicant respectfully requests that the Examiner provide an affidavit attesting to the facts alluded to and why the Examiner is in a position to make such a determination. Additionally, the Applicant respectfully requests that the Examiner provide documentary support for the facts alleged to be true and of which the Examiner has taken official notice. Without such evidence and additional reasoning, the Applicant is left in the position of not being able to adequately respond to the Office Action.

Also, since the Office Action did not allege sufficient facts and provide sufficient documentary evidence to support the rejections thereby depriving the Applicant of a reasonable opportunity to rebut those allegations, the Applicant hereby respectfully requests that the finality

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AMENDMENT AND RESPONSE  
SERIAL NO. 10/716,272

of this office action be withdrawn and a new office action issued should the Examiner refuse to allow the claims and maintain the rejections of the claims.

**CONCLUSION**

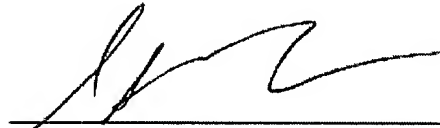
Applicant respectfully submits that the Application is in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

No fees are believed to be due at this time. However, the Commissioner is authorized to charge any additional fees or refunds that may be required by this paper to Deposit Account No. 05-0765.

Respectfully submitted,  
THE LAW OFFICE OF STEPHEN R. LOE

Dated: \_\_\_\_\_

8/23/2007



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